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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,182	06/15/2001	Jean-Paul Vidot	CELA:082	6962

7590 01/14/2004

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EXAMINER
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LUONG, VINH

ART UNIT	PAPER NUMBER
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3682

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/868,182

Applicant(s)

VIDOT ET AL.

Examiner

Vinh T Luong

Art Unit

3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-11 and 29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-11 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.



Vinh T. Luong  
Primary Examiner

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 15.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *Exhibits & Translation*.

1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the previous Office action on July 23, 2003 has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 24, 2003 (Paper No. 16) has been entered.

2. The restriction and election with traverse of the species of Figs. 1-3 in parent application are carried over to the instant RCE. No claim is withdrawn from further consideration pursuant to 37 CFR 1.142(b).

3. The abstract of the disclosure filed on November 24, 2003 is objected to because of the legal phraseology "means." Correction is required. See MPEP § 608.01(b).

4. The proposed drawing corrections and/or the proposed substitute sheets of drawings filed on November 24, 2003 have been partially approved as explained below:

(a) The proposed drawing corrections and/or the proposed substitute sheets of drawings of original Figs. 2 and 3 have been approved; and

(b) The proposed drawing corrections and/or the proposed substitute sheets of drawings of new Fig. 9 has been disapproved new Fig. 9 introduces new matter into the drawings. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of, *e.g.*, the following elements:

(1) The curved groove 19a. Applicant states on page 16 of Paper No. 16 that the groove 19a is not new matter because the original specification at page 8,

lines 24-26, describes “conical external profile 18 that cooperates with *a groove having a matching profile 19.*” However, the original Fig. 2 shows that the conical external profile 18 and matching profile 19 are straight or linear (see Exhibit I attached), therefore, the groove that is matched with the *straight* conical external profile 18 and the straight matching profile 19 is inherently straight. Meanwhile, Fig. 9 shows that groove 19a is curved. The curvature of the groove 19a is unsupported by the original record, i.e., new matter;

(b) The tips 15 that are bent inward radially and uniformly as now shown in Fig. 9. Applicant contends that the original specification, such as, at page 8, lines 20-23; page 10, lines 28-32; and page 11, lines 8-12, provides support for the bending of the tips 15 as now shown. Although the original specification discloses that the tips are *deformable* or *flexible*, however, the original disclosure does not specifically disclose that the tips 15 are bent inward radially and uniformly as now shown. In other words, the original disclosure implies that the tips 15 can be deformed by expansion, contraction, and/or bending radially outward or inward relative to the axis 9 in a uniform or non-uniform manner. The specific showing of a deformation, bending, or flexing of the tips 15 within a full spectrum of possible deformabilities, bendings, or flexibilities of the tips 15 is considered under the present disclosure to be new matter. *Cf., In re Smith*, 173 USPQ 679 (CCPA 1972) and *Ex parte George*, 230 USPQ 575, 578 (BPAI 1986). On the other hand, the concept that the tips 15 are bent radially and uniformly inward relative to the axis 9 is not conveyed in the

original disclosure, i.e., new matter. *In re Anderson*, 176 USPQ 331 (CCPA 1973); and

(c) The size, shape, and configuration of the chamber 27. The original specification does not disclose that the chamber 27 is changed in size, shape, and configuration, etc. as now shown in new Fig. 9. The specific showing of a size, shape, and configuration of the chamber 27 within a full spectrum of possible sizes, shapes, and configurations is considered under the present disclosure to be new matter. *Cf., In re Smith* and *Ex parte George, supra*.

5. The *original* drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed features, such as, (a) the locking means which is released with the first external surface of the piston in claim 1; and (b) the external profile 18 which is disengaged from the matching profile 19 of the matching second surface in claim 7 must be shown or the features canceled from the claims. *No new matter should be entered.*

The original Fig. 2 shows that the profiles 18 and 19 form a straight line, thus, they are engaged from each other. The moved or alternate positions, such as, the engaged and disengaged positions of the locking means 15 and the profiles 18 and 19 are required to be shown in accordance with 37 CFR 1.84(h)(4).

6. The amendment filed May 14, 2003 and November 24, 2003 are objected to under 35 U.S.C. 132 because they introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the description of new Fig. 9 in

the specification on page 7, lines 11-34; page 8, lines 5-6, lines 10-15, and lines 24-26. For example, the new elements in new Fig. 9 as shown in Exhibit attached are unsupported by original disclosure. Applicant is required to cancel the new matter in the reply to this Office Action.

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1-3, 5-11 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear whether the term that appears at least twice, such as, "first and second mechanical elements" in lines 2, 3, and 5 of claims 1 and 3 refer to the same or different things. See MPEP 2173.05(o).

The term, such as, "releasable" in line 20 of claim 1 is vague and indefinite in the sense that things which may be done are not required to be done, *e.g.*, the locking means is releasable, but is not required structurally to be released from the first external surface of the piston. See "crimpable" and "discardable" in *Mathis v. Hydro Air Industries*, 1 USPQ2d 1513, 1527 (D.C. Calif. 1986); "removable" in *In re Burke Inc.*, 22 USPQ2d 1368, 1372 (D.C. Calif. 1992) and "comparable" in *Ex parte Anderson*, 21 USPQ2d 1241, 1249 (Bd. Pat. App. & Inter. 1992).

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claim 1, as best understood, is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,662,702 B1 (hereinafter Pat.'702). Although the conflicting claims are not identical, they are not patentably distinct from each other because applicant apparently uses a slightly different terminology in order to claim substantially the same invention. *In re Griswold*, 150 USPQ 804 (CCPA 19966) and MPEP 804.02. In the instant case, claim 1 of this case and claim 1 of Pat.'702 claim common elements, such as, first and second (mechanical) elements, at least one pyrotechnic component, at least one locking means, and retention means comprising a piston/cap having a first external surface/head.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to interchange the piston having the first external surface claimed in the instant application with the cap having the head claimed in Pat.'702 in order to releasably engage

with the locking means as taught or suggested by common knowledge in the art since the piston having the first external surface is functionally equivalent to the cap having the head.

11. Claims 1, 2, and 29, as best understood, are rejected under 35 U.S.C. 102(a) as being anticipated by Camp'372 (German Patent No. 196 17 372 C1 cited in applicant's corresponding PCT application).

Regarding claim 1, Camp'372 teaches a pyrotechnically unlockable mechanical linking device 30 between first and second mechanical elements 26 and 18 (Fig. 1) for receiving tensile and/or compressive forces along a first axis (at 24 in Fig. 2), said device comprising:

first and second mechanical elements 26 and 18;

at least one pyrotechnic component 50, 52 (Fig. 2);

retention means 44 for release by pressure of gases generated by igniting the pyrotechnic component 50, 52; and

at least one locking means 48 (i.e., a housing-firm notice, see *Alta Vista* translation attached) having an axial bore 32 and linking together said first and second mechanical elements 26 and 18 by applying a linking force along at least a second axis (see Exhibit II attached), said locking means 48 for release when the mechanical elements 26 and 18 are subjected to tensile and/or compressive forces along said first axis 24 and held in a locking position by said retention means 44, wherein

the retention means comprise a piston 44 having a first *external* surface (i.e., a surface that is abutted with the housing-firm notice 48. See translation and Exhibit II) for sliding in said axial bore 32 in response to gas pressure generated by the pyrotechnic component 50, 52, the locking means 48 being in *releasable locking engagement* with the first external surface of



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the piston 44, which ensures retention of the locking means 48 in the locking position for unitary movement of said first and second mechanical elements 26 and 18.

Claim 1 and other claims below are anticipated by Camp'372 since Camp'372 teaches each and every positive claimed element including its functional statement. See *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781, 789 (CAFC 1983). In fact, note that the piston 44 is biased by the spring 46 to slide back and forth inside the housing (axial bore) 32. Therefore, the first external surface of the piston 44 is engaged with and disengaged (released) from the housing-firm notice 48. In other words, the locking means 48 acts as a stop and it is in releasable locking engagement with the first surface of the piston 44. On the other hand, it is well settled that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967); and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding claim 2, the locking means 48 are linked with said first mechanical element 26 and comprise at least one first (vertical) surface 48 (Exhibit II) having a profile 48 for cooperating with a second (horizontal) surface (Exhibit II) having a matching profile *integral* with said first mechanical element 26. The locking means 48 also delimits at least partially the axial bore 32 for slidably receiving the piston 44. Note that the term "integral" is not restricted to a one-piece article. The term "integral" is sufficiently broad to embrace constructions united by such means as fastening and welding. See *In re Hotte*, 177 USPQ 326 (CCPA); *In re Clark*,

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102 USPQ 241 (CCPA); *In re Dike*, 157 USPQ 581 (CCPA); *In re Kohno*, 157 USPQ 275 (CCPA); and *In re Morris*, 43 USPQ2d 1753, 1757 (CAFC 1997).

Regarding claim 29, Camp'372's first mechanical element 26 is integral with one end of a rod 26 of a master brake cylinder for a vehicle and the second mechanical element 18 is integral with a brake pedal 18.

12. Claims 3 and 5-11 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph.

13. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

14. Applicant's arguments filed November 24, 2003 have been fully considered but they are not persuasive.

With respect to the interview summary, applicant states that the examiner agreed that the words "releasable locking engagement" in claim 1 overcome the rejection based on Camp'372 during the personal interview on November 20, 2003.

The examiner respectfully submits that in the final rejection on July 23, 2003, the examiner interpreted locking means comprising the elements 32 and 40 of Camp'372. Since Camp'372's bolting device element 40 is not released from the piston 44, therefore, the examiner agreed as stated in the interview. However, applicant's amendment necessitates new interpretation of Camp'372. Upon reconsideration, in the instant Office action, the examiner interprets the locking means comprising the housing-firm notice 48 but not the element 40. Since Camp'372's Fig. 2 shows that the piston 44 is engaged with and disengaged from the stop

48, therefore, applicant's amended claim 1 is "fully met" by Camp'372. See *Kalman v. Kimberly Clark Corp.*, *supra*.

In the following, the examiner answers applicant's remarks in the same numerical order used by applicant.

1. Applicant asserts that the abstract is amended in accordance with the current rule. However, the abstract still uses the legal phraseology "means," thus, the objection is reiterated.

2. DE 195 15 852 has been considered as seen in Form PTO-1449 attached.

3. Applicant insists that new Fig. 9 does not introduce new matter. The examiner respectfully submits that new Fig. 9 introduces new matter as explained in the disapproval of proposed drawing correction above. Further, applicant's attached Exhibit I with applicant's numerous hand written notes does not support applicant's arguments of no new matter because applicant refers to new Fig. 9 itself which is *not a part of the original record*. The drawing disapproval of Fig. 9 is maintained for the reasons stated in the disapproval of proposed drawing correction above. However, the proposed correction of Figs. 2 and 3 have been approved in view of applicant's remarks.

4. The objection to the introduction of new matter into the disclosure is maintained because new Fig. 9 is unsupported by the record as filed as explained above.

5. The objection to sectional reference symbols (planes) has been withdrawn. See the approval of Figs. 2 and 3.

6. Amended claims 1-3, 5-11, and 29 are indefinite. See the above rejection under 35 USC 112, second paragraph.

7. Applicant alleges that while Camp'372's locking means 32, 40 releasably abuts against the piston 44, however, it does not lock with the piston 44 as required by applicant's amended claim 1.

Applicant is respectfully noted that, during patent examination, claims are given their broadest reasonable interpretation consistent with the specification. It is proper to use the specification to interpret what the applicant meant by a word or phrase recited in the claim. However, it is not proper to read limitations appearing in the specification into the claim when these limitations are not recited in the claim. See *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994); and *IntervetAmerica Inc. v. Kee-Vet Lab. Inc.*, 887 F.2d 1050, 1053, 12 USPQ2d 1474, 1476 (Fed. Cir. 1989). In addition, anticipation law requires distinction be made between invention described or taught and invention claimed. It does not require that the reference "teach" what subject patent application teaches, it is only necessary that the claim under attack, as construed by the Court, "*read on*" something disclosed in the reference, *i.e.*, all limitations of the claim are found in reference, or are "*fully met*" by it. *Kalman v. Kimberly Clark Corp.*, *supra*.

In the instant Office action, the locking means includes the stop 48 but not the bolt 40. Camp'372's Fig. 2 shows that the piston 44 is engaged with and disengaged from the locking means 48. When the piston 44 is abutted against the stop 48, it is locked with the stop 48 as now claimed. The rejection under 35 USC 102(a) is, therefore, maintained.

15. Applicant's arguments with respect to claims 1-3, 5-11, and 29 have been considered but are moot in view of the new ground(s) of rejection.

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16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 703-308-3221. The examiner can normally be reached on Tuesday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci can be reached on 703-308-3668. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Luong

January 8, 2004

A handwritten signature in black ink, appearing to read 'Vinh T. Luong', with a long horizontal line extending to the right.

Vinh T. Luong  
Primary Examiner